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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,648	05/14/2001	Amy J. Donnan	DON0002/US/2	8779
33072	7590	09/28/2004	EXAMINER	
KAGAN BINDER, PLLC SUITE 200, MAPLE ISLAND BUILDING 221 MAIN STREET NORTH STILLWATER, MN 55082			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,648

Applicant(s)

DONNAN, AMY J.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 6-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the structural features encompassed by the phrase "tear drop-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 7, the structural features encompassed by the phrase "sun-shaped" can't be determined.

Regarding claim 8, the structural features encompassed by the phrase "fire-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 9, the structural features encompassed by the phrase "ghost-shaped" can't be determined, rendering the claim indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 13-16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In analyzing claim 1 for patent eligible subject matter, it is useful to first answer the question "What did applicant[s] invent?" In re Abele, 214 USPQ 682 (CCPA 1982). While the preamble of claim 13 characterizes the invention as a "method for exploring emotional experience...", a careful reading of the specification reveals that the applicant's invention can best be described as a kit which having articles which in turn create an environment conducive to the exploration of an emotional experience.

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that any exploration of an emotional experience will be predictably enabled by the steps set forth. There is simply too much subjectivity involved because the process effectively relies on the state of mind of the participants rather than an objective standard. Actual exploration of an emotional

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experience, is completely up to the participants. The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a "tangible" result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). In other words even if a user is able to explore an emotional experience, such a result is merely an abstraction lacking in substance, it is only thoughts or emotions without any physical outcome or manipulation of any physical substance and therefore do not represent a use having any real world value. The method does not produce a physical transformation and yields no tangible result. It is thus effectively a manipulation of abstract ideas and is thus not statutory.

Claims 13-16 and 18 do not produce a useful, concrete, tangible result. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claims 13-16 and 18 do not define statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoose in view of Shaver et al. Van Hoose discloses an interactive toy containing most of the elements of the claims including, providing a plurality of playpieces (fig. 3) as required by claims 1 and 13, each playpiece symbolic of particular emotion (col. 2, lines 35-47) as required by claims 1 and 13, each playpiece comprising a unique shape with respect to the other playpieces (elements 29, 31, 33, 35, 37 and 39) as required by claims 1 and 13, providing a container comprising a storage chamber as required by claims 1 and 13 (element 23 and 45), a first playpiece generally symbolic of love (35) as required by claim 4, a second playpiece generally symbolic of sadness as required by claim 4 (33), a third playpiece generally symbolic of happiness (31) as required by claim 4, a fourth playpiece generally symbolic of fear (29) as required by claim 4, one or more playpieces comprising one or more panels enclosing a stuffing material (col. 5, lines 18-21 and fig. 3, element 35), a container being heart shaped and a plush pillow bag as required by claims 11 and 12 (elements 23 and 45). Van Hoose further discloses interacting with a toy as required by claims 13-15 (col. 3, lines 6+). Regarding the shapes required by claims 6-9, it is considered that the shapes of the play-pieces, 29, 31, 33, 35, 37 and 39, read on all the shapes required (as best understood). Furthermore, the specific shapes encompassed by claims 6-9 are an obvious design choice in that the applicant discloses no critical need or advantage for them.

Although Van Hoose discloses most of the elements of the claims, as stated above, including each playpiece having a color (col. 2, lines 36-47) the reference fails to

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teach each playpiece comprising a unique color as required by claims 1 and 13, each playpiece comprising a unique facial expression comprising eyes and mouth as required by claims 1 and 13, a separate playpiece generally symbolic of anger as required by claim 4, and naming an emotion corresponding to a playpiece as required by claim 16. However, Shaver discloses an interactive toy like that of Van Hoose, which teaches the use of a unique color for a plurality of playpieces generally symbolic of a particular emotion (col. 4, lines 58-59 and figs. 10a-10g) as well as a unique facial expression for demonstrating a particular emotion (col. 4, lines 43-46 and figs. 9a-9j). Shaver further teaches that it is know to have user name the emotion corresponding to a playpiece, as required by claim 16, in col. 5, lines 28-37. Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to incorporate the teachings of Shaver in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing playpieces which are distinctive in appearance from each other. It would have been further obvious to provide the toy of Van Hoose with a separate playpiece generally symbolic of anger, especially since Van Hoose recognizes anger as an emotion which needs to be displayed (col. 2, line 39) and since representation of anger as an emotion is well known in the art. It would have been further obvious to including the step of naming an emotion corresponding to a playpiece for the purpose of clearly identifying a child's emotions.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoose in view of Shaver et al (as stated above) and further in view of

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Childsworld/Childsplay "Feelings Frogs Game". Van Hoose discloses most of the elements of the claims, as stated above, but for each playpiece comprising textual information indicative of a particular emotion corresponding to a playpiece as required by claims 17-18. However, Childsworld/Childsplay discloses interactive playpieces which teach the use of a unique color and the use of textual information for a plurality of playpieces generally symbolic of a particular emotion (see Childsworld/Childsplay "Feelings Frogs Game", page 22). Therefore it would have been obvious to incorporate the teachings of Childsworld/Childsplay in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing playpieces which are distinctive in appearance from each other.

Response to Arguments

Applicant's arguments filed June 3, 2004 have been fully considered but they are not persuasive. Applicants argue that the shapes as claimed fully meet the requirements of USC 112, 2nd paragraph. As support applicants list a variety of patents which use shape descriptive terminology, such as "teddy bear", "tear-drop shape", "heart shape" among others. In response the examiner points out that none of the patents listed by the applicants appear to use terms such as, "sun-shaped", "fire shaped" or "ghost shape" in the claim language. The examiner further points out that USC 112, 2nd paragraph stipulates that:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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In this case the use of language such as "tear drop-shaped", "sun-shaped", "fire-shaped", "ghost-shaped" is not a distinct shape which has clear metes and bounds. For example, a tear drop shape could be a variety of shapes such as a circle, oval, or blob with no clear defined boundaries, a sun shape can be a variety of shapes such as a circle, an oval, a half circle among others and as to a fire shape the examiner can't even begin to describe the variety of shapes that are encompassed by such a term.

Applicants further point to a definition for a tear-drop shape, however it should be pointed out that Merriam-Webster's Collegiate Dictionary, Tenth Edition defines a tear drop shape as "something shaped like a dropping tear" with no other stipulations and keeping in mind the variety of shapes that are encompassed by a drop of falling liquid, as stated above, the term is indefinite. Furthermore the examiner is puzzled as to why the applicants simply do not use clear and concise terms to define their shapes and not ambiguous and unclear language as is currently used in order to clearly define their playpiece shapes.

Applicants further argue that since patents drawn to psychological methods have been issued that have not achieved a specific tangible result then therefore their method claims are statutory under 35 USC 101. In response the examiner points out that a recently developed test for the determination of patent eligible matter is whether the invention produces a useful, concrete and tangible result. See e.g., State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have a practical utility, it must produce an assured result,

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and it must not be merely an abstraction lacking in physical substance. In this case the claims (e.g. claim 1) merely set forth steps which provide a toy and associated play pieces and interacting with the toy in order to explore an emotional experience. In which case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that any exploration of an emotional experience will be predictably enabled by the steps set forth (i.e. mere interaction with the toy by a user, such as a child, has a good chance of simply resulting in play without any exploration of any emotional experience). Furthermore, the steps fail to produce a "tangible" result in any way. In other words, even if a user is able to explore an emotional experience, such a result is merely an abstraction lacking in substance, it is only thoughts or emotions without any physical outcome or manipulation of any physical substance and therefore do not represent a use having any real world value.

Applicants further argue Van Hoose fails to teach playpieces that are unique in color as well as shape as required by the claims. In response the examiner points out that the pieces relied upon by the applicants (i.e. 45 and 46) as purportedly failing to teach a specific shape are NOT playpieces relied upon by the examiner and Van Hoose since they are not within the group of playpieces drawn to a particular emotion as taught in col. 2, lines 35-36. While the uniqueness of color is clearly taught by the Shaver reference where Shaver teaches providing playpieces representative of a particular emotion which have a distinct and unique color, therefore obviating the use of a unique color in the playpieces of Van Hoose (col. 4, lines 58-60).

In response to applicants argument that the motivation used by the examiner to combine the references is somehow improper, the examiner points out that the Van Hoose discloses an invention that utilizes a plurality of colored playpieces having unique shapes that are manipulated by a user in order to identifying specific emotions and thus achieve attitudinal healing. However Van Hoose discloses two of his playpieces as having the same color (i.e. lips and a heart both representative of good emotions such as love and joy are red, col. 2, lines 40-44). Shaver also discloses a device for attitudinal healing, but goes further than Van Hoose by teaching the use of a unique color (col. 4, lines 58-60) for playpeices symbolic of a particular emotion for the purpose of providing playpieces which are distinctive in appearance from all other playpieces (col. 2, liens 24-28). Thus it would have been obvious to one having ordinary skill in the art to incorporate a unique color for the playpieces of Van Hoose for the purpose of providing playpieces which are distinctive in appearance so that an emotion can be clearly identified and relayed by the user since both inventions are drawn to emotional healing.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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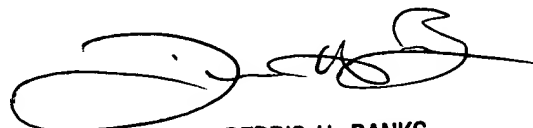
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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